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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 03/26/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary*File copy*

Application No.

10/019,331

Applicant(s)

SAMAIN ET AL.

Examiner

JYOTHSNA A VENKAT

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Receipt is acknowledged of priority document, IDS, declaration and preliminary amendment A filed on 12/28/01, 2/8/02 and 3/21/02.

The preliminary amendment canceled claims 1-20 and added claims 21-52 in the application. Claims 21-52 are pending in the application and the status of the application is as follows:

Information Disclosure Statement

The references cited in the Search Report has been considered, because they were provided on a separate list in compliance with 37 CFR 1.98(a)(1).

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 21-52 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is a written description rejection.**

To satisfy the Written description requirement, applicant must convey with reasonable clarity to one skilled in the art, as of the filing date that applicant were in possession of the claimed invention. Applicant's claims are drawn to "*a cosmetic hair composition comprising in a cosmetically acceptable medium, solid particles and at least one adhesive polymer wherein when the composition is dried, the resulting dried material has detachment profile defined by at*

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least one maximum detachment force F_{max} of greater than 1N., wherein F_{max} , as measured by extensometer, is the maximum tensile force needed to detach the surfaces of two respective rigid, inert, nonabsorbent supports (A) and (B), wherein said surfaces have each have a surface area of 38 mm^2 and wherein said supports are placed facing each other; and further wherein: said surfaces are precoated at a concentration of $53/c$ micrograms/ mm^2 with a formulation comprising said at least one adhesive polymer in the cosmetically acceptable medium, where in c is the concentration of solids in the formulation, expressed in grams per gram of composition; and said precoated surfaces are dried for 24 hours at 22^0 C , under a relative humidity of 50%, then subjected for 20 seconds to a compression of 3N, and then subjected to detachment at a speed of 20 mm/minute for 30 seconds to determine F_{max} .

The instant application fails to describe specific examples of adhesive polymers that satisfy the criteria of claims 21-26. The specification describes the adhesive polymer which satisfy this criteria, at page 4 as AQ 1350 sold by Eastman Kodak. There is no structure given to this polymer except for the trademark name. This polymer has the detachment force F_{max} greater than 1. This is the only polymer described and exemplified. The criteria for the dried material in claim 24 is that the dried material has a glass transition temperature of less than $+10^0\text{ C}$. The AQ polymer has a glass transition temperature of 0^0 C . The functional language recited in the claims without defining the suitable adhesive polymers, does not meet the written description requirement as one of ordinary skill in the art could not recognize or understand the polymers that satisfy the requirement from the mere recitation of the function. Claims employing functional language at the point of novelty, such as applicants', neither provide those elements required to practice the inventions, nor "inform the public" during the life of the patent of the

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limits of the monopoly asserted. Applicants claimed expression represents only an invitation to experiment regarding possible polymers suitable as adhesive polymers, which can be used in the cosmetic compositions.

3. Claim 37 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is a new matter rejection..**

4. There is no support in the specification for “ketones, alkyl acetates, and di-alkoxy substituted alkanes”. the specification describes at page 10, 2nd paragraph two compounds under ketones, which are acetone and methyl ethyl ketone. The same is true for acetates and di-alkoxy substituted alkanes. Description for two specific compounds in each category is not a support for the entire genus.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 43 and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following reasons apply:

I. The expression “thilos” as reducing agents lacks clarity and unclear as to applicants intent. Thiols contain the sulfhydryl group, -SH. These are the sulfur analogs of alcohols. What is the other moiety attached to sulfur that function as reducing agent. The conventional reducing agents are thioglycolic acid, thiolactic acid, cysteine, glycol

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thioglycolate, glycerol thioglycolate, and dimercaptodipic acid. What specific compounds are contemplated for “ thiols”?

II. The expression “ anionic silicones” is without metes and bounds. Recourse to the specification does not define these class of compounds. Are these linear or cyclic or volatile or non-volatile?

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 21-38, and 42 are, rejected under 35 U.S.C. 102(b) as being anticipated by U. S. patent 5,053,221 ('221).

9. The claims are drawn to compositions and claims recite the functional language which is *when the composition is dried, the resulting dried material has detachment profile defined by at least one maximum detachment force F_{max} of greater than 1N., wherein F_{max} , as measured by extensometer, is the maximum tensile force needed to detach the surfaces of two respective rigid, inert, nonabsorbent supports (A) and (B) , wherein said surfaces have each have a surface area of*

38 mm² and wherein said supports are placed facing each other: and further wherein:

said surfaces are precoated at a concentration of 53/c micrograms/mm² with a formulation comprising said at least one adhesive polymer in the cosmetically acceptable medium, where in c is the concentration of solids in the formulation, expressed in grams per

gram of composition ; and

said precoated surfaces are dried for 24 hours at 22⁰ C, under a relative humidity of 50%, then subjected for 20 seconds to a compression of 3N, and then subjected to detachment at a speed of 20 mm/minute for 30 seconds to determine F_{max} .

The office is not equipped to manufacture the composition and then drying the composition so that it satisfies the functional criteria of claims 21-26. Therefore the claims are anticipated, absence of evidence to the contrary.

See col.2, lines 30-45 for the beads which read on the claimed particles. There is overlap of concentration and particle size. See the paragraph bridging col.s 3-4 for the adhesive polymer and see col.4, lines 18 et seq and col.5, lines 1-60 for the AQ polymers. The polymer disclosed in the patent reads on the claimed adhesive polymer. See the examples for ethanol which read on the solvent, see col5, lines 60 et seq and col.6 for the additives.

10. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT whose telephone number is 703-308-2439. The examiner can normally be reached on M-F, 9:30-6:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-308-7924 for After Final communications.

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the patent reads on the claimed adhesive polymer. See the examples for ethanol which read on the solvent, see col5, lines 60 et seq and col.6 for the additives.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


JYOTHSNA A VENKAT
Primary Examiner
Art Unit 1615

March 21, 2003